

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	:	3692	Customer No. 035811
Examiner	:	Harish T. Dass	
Serial No.	:	09/970,600	Docket No.: 1480-R-00
Filed	:	October 4, 2001	
Inventors	:	William H. Wisecarver III	
	:	Mary F. Nugent	Confirmation No.: 1951
Title	:	SYSTEM AND METHOD FOR ON-LINE PAYMENT TRANSACTIONS	Dated: November 30, 2009

RESPONSE TO EXAMINER'S ANSWER

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed on October 29, 2009, and the Examiner's supplemental Office communication mailed on November 19, 2009, the Appellants herein Respond as follows:

(4) Status of the Amendments After Final

The Examiner alleges that Appellants' statement of the status of amendments after final rejection is incorrect and notes that the amendment after final filed on July 2, 2009 has not been entered.

However, the Appellants acknowledged that the after final amendment was not entered. (*see* Appellants' Appeal Brief at pg. 2, lines 7-9). As a result, the Appellants are not sure what the Examiner is protesting.

(9) Grounds of Rejection

1. Claims Rejected under 35 USC §112 – The Appellants provided explicit and clear support for the features: “merchant account”, “no funds are stored”, and “lock box account does not store funds” during prosecution and in Appellants’ Appeal Brief (*see* Appellants’ Appeal Brief at pg. 9, line 11 – pg. 11, line 10). During prosecution, the Appellants explained such support in, for example, Appellants Response dated February 14, 2008 (*see*, for example, pg. 8 , line 1 – pg. 9, line 7). Notably, in the Office Action that followed Appellants’ February 14, 2008 Response, the §112 rejections were withdrawn, indicating that support was adequate for the foregoing features. Inexplicably, the Examiner re-raised these rejections after having already been resolved.

(10) Response to Arguments

1. In Response Examiner’s Answer...

a.) beginning at pg. 10, line 8 (regarding the terms “merchant” vs. “merchant account”) - The Appellants submit that the terms “merchant” and “merchant account”, in the context of the specification, are interchangeable; and that this was fully explained to the Examiner during the course of prosecution. In fact, after being explained, it was the Examiner that suggested amending “merchant” to “merchant account” for clarity. The Appellants made the amendment solely to accommodate the Examiner. (*see* Appellants’ Brief at pg. 9, line 17-pg. 10, line 15). As a result, Appellants’ amendment to revert the claims to their pre-amendment form should have been entered; and such an amendment should not have been deemed to add new matter, particularly since the claims, in their pre-amendment form, had already been examined.

b.) beginning at pg. 11, line 4 (regarding “lock box account does not store funds) – To begin, it is noted that the specific argument now raised by the Examiner was already raised,

verbatim, in an Advisory Action mailed on January 30, 2008. The Appellants fully addressed this argument in Appellants' February 14, 2008 Response (*see* pg. 7, for example). Appellants' response was again pointed out in Appellants' Brief at pg. 10, line 16-pg. 11, line 6. Notably, Appellants' February 14, 2008 Response was accepted as all rejections relating to the "lock box account does not store funds" feature were fully withdrawn in the very next Office Action (mailed June 12, 2008). As in the case of the "merchant" feature, the Examiner inexplicably re-raised a rejection which Appellants had previously resolved.

c.) beginning at pg. 14, line 1 (regarding Appellants' alleged failure to "show which limitation is not covered by the office action") –The Appellants explicitly identify in Appellants' Brief those limitations to which Cheong (the primary reference) has not been applied. (*see* pg. 14, last paragraph of Appellants' Brief). Further, the Appellants take exception and fully traverse the Examiner's assertion that Appellants' alleged failure is to be taken as any sort of admission. To the contrary, the Appellants explicitly traverse all of the Examiner's assertions and/or rejections unless otherwise noted. Indeed, many of the Examiner's rejections appear unfounded and irrelevant (as being applied to elements that are not even claimed, for example), and as a result, are impossible to address. (*Id.*)

d.) beginning at pg. 14, line 16 (regarding the Examiner's failure to provide a citation for where the "requesting funds from a consumer's established credit card account..." feature is disclosed) – As explained in Appellants' Appeal Brief at pg. 15, lines 3-12, Cheong discloses routing funds from directly from a pre-funded surrogate card account, and not from a consumer's established credit card. The pre-loaded surrogate card (of Cheong) is an account into which funds were paid prior to any transaction, whereas the credit card is an account which is unfunded, and which the consumer is required to pay after the transactions has occurred. In

essence, paying with Cheong is akin to paying in cash, whereas the claimed payment process does not require upfront payments of any kind.

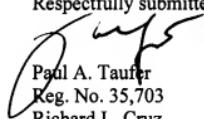
e.) beginning at pg. 16, line 3 (regarding Appellants' alleged failure to traverse Examiner's errors) – This alleged 'failure' has been fully addressed at pg. 16, first paragraph of Appellants' Appeal Brief, in which Appellants explain that the Examiner's official notice(s) are unsupported by any evidence, and further, that the Examiner failed to apply any of the official notice(s) to any of the claims. (*Id.* at lines 1-15).

f.) beginning at pg. 17, line 15 (regarding Appellants' alleged failure to add a limitation without underlining the same) – The Appellants acknowledge that they inadvertently failed to underline the limitation of "consumer credit card account is stored in the lock box account" when it was added to the claims in Appellants' December 4, 2008 Response. However, during prosecution and prior to filing Appellants' Appeal Brief, the Appellants explicitly identified and argued for the patentability of this feature. (see, for example, pg. 11, lines 1-3 of Appellants' July 2, 2009 Response). As a result, the Examiner was fully aware of this feature, but nonetheless, failed to address it. Accordingly, since the Examiner failed to cite any prior art disclosing this feature, Appellants submit that Claim 1, and all claims that depend thereon, are fully patentable over all prior art of record.

ALL OTHER statements, assertions, contentions and/or explanations provided in the Examiner's Answer that have not been explicitly addressed above shall not be taken as Appellants' acceptance thereof. To the contrary, the Appellants hereby traverse all such

statements, assertions, contentions, and/or explanations for at least those reasons set forth in the
Appellants' Appeal Brief.

Respectfully submitted,



Paul A. Taufer
Reg. No. 35,703
Richard L. Cruz
Reg. No. 52,783
Attorneys for Applicants

PAT/RLC/nn
215-656-3385